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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,354	02/17/2004	Manfred Grundei	4452-614	9952
27799	7590	06/06/2005	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			KRAMER, DEVON C	
			ART UNIT	PAPER NUMBER
			3683	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,354

Applicant(s)

GRUNDEI, MANFRED

Examiner

Devon C Kramer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10 and 13 is/are rejected.
- 7) ☐ Claim(s) 12 14 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/22/04 2/17/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1) Applicant's election without traverse of Species 1 (Figure 1) in the reply filed on 5/6/05 is acknowledged.

2) Claims 7-9 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/6/05.

Specification

3) The disclosure is objected to because of the following informalities:

Paragraph 35 line 8, "cylinder 1" should be --cylinder 33--.

Appropriate correction is required.

Claim Objections

4) Claims 1-6, 10, and 12-15 objected to because of the following informalities:

Claim 1 line 10, "working spaces" should be --the working spaces--;

Claim 1 line 13, claim 1 line 16, claim 5 line 2, and claim 6 line 1, "the valve disk" should be --the first valve disk--;

Claim 12 line 3, "said first pressure actuated area" should be --said first pressure actuated surface--;

Claim 13 lines 1-2, "said second pressure actuated area" should be --said second pressure actuated surface--;

Claim 15 lines 5-6, "the valve disk" should be --the second valve disk--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 5) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 6) Claims 5, 10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites "into the working space opposite said disk from the piston". This is unclear because applicant defined the working spaces in claim 1 relative to the piston rod and not the piston.

Claim 13 recites the limitation "said valve seating surfaces" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

- 7) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 8) Claims 1-4 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lan (5477589).

In re claims 1-4 and 13, Lan provides a vibration damper comprising: a cylinder (20) containing a damping medium, a piston rod (30) extending from said cylinder, a piston (42) connected to said piston rod, said piston having a piston rod side (A) and a

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side away (B) from said piston rod, said piston separating said cylinder into a working space on the piston rod side and a working space on the side away from the piston rod; a bypass (22) connecting said working spaces when the piston is in a limited range of positions, at least one first through-channel (423', 431') for flow in a first direction between working spaces through the piston, each said first through-channel having an outlet side; and a first valve disk (435, 436) covering said outlet side and having a first pressure-actuated surface upon which pressure can act to lift the valve disk from a closed position to an open position to permit flow in said first direction, and a second pressure actuated surface which is separated from the first pressure-actuated surface when the valve disk is in the closed position and can be acted on by damping medium via the bypass so that the pressure on the first and second pressure actuated surfaces of said first valve disk is additive.

Allowable Subject Matter

9) Claims 5-6, 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10) Claims 12, 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

11) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lan '511, Nakadate et al, Perrin, Grundei et al and Nezu et al all provide pistons with bypass arrangements.

12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devon C Kramer whose telephone number is 571-272-7118. The examiner can normally be reached on Mon-Fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Devon C Kramer
Examiner
Art Unit 3683

DK

DEVON C. KRAMER
PATENT EXAMINER

Devon Kramer
5/27/05